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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,771	11/03/2000	Michael F. Marlin		4378

7590 12/01/2005

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EXAMINER	
MILLER, BENA B	
ART UNIT	**PAPER NUMBER**
3725	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/704,771	MARLIN, MICHAEL F.	
	Examiner	Art Unit	
	Bena Miller	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 22-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 22-27 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Bena B. Miller

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-24 and 27 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Brannon (US Patent 4,830,244) as set forth in the previous Office Action.

Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Brannon in view of Bidwell as set forth in the previous Office Action .

Claim 26 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Brannon in view of Molenaar as set forth in the previous Office Action.

Response to Arguments

Applicant's arguments filed 08/26/05 have been fully considered but they are not persuasive. The Examiner has noted that the prior art of record used in the rejection set forth above is Brannon not Brennan. Therefore, for the purposes of the response to the arguments, the Examiner will refer to the prior art of record, Brannon (The Examiner presumes that the prior art which Applicant refers is a typographical error).

In response to applicant's argument that Brannon is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Brannon teaches the elements as defined in the claims as set forth above. Further, the Examiner takes the position that the device of Brenan can be used as a "toy". The device of Brenan would not prevent one, i.e., a child, from using the device as a toy. It is known to use a fishing device as a toy. Applicant attention is directed to US Patent 3,484,979, which is a toy manually operated reel that can be used as a fishing device, which is in same field of endeavor as the prior art, Brannon. Therefore, the Examiner takes the position that prior art, Brannon is analogous and is reasonably pertinent to the particular problem of the claimed invention. It should also be noted that the recitation a flexible retractable-coiled toy has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In reference to Applicant's remarks that the device of Brannon is not made of plastic, it should be noted that it is well known to make a wire, such as the wire as

disclosed by the device of Brannon, of plastic. Applicant's attention is directed to US Patents 4,827,661; 4,960,231; 3,893,605; 2,812,125, which supports the Examiner's position as set forth in the above rejection that it would have been obvious to one having ordinary skill in the art to use a plastic wire for the device of Brannon. Further, the Examiner disagrees with the Applicant's contention that the Examiner did not include in the Office that Brannon has a handle. The Applicant's attention is directed to the paragraph 4 of the previous Office Action.

In reference to Applicant's remarks that the phrase "consisting essentially of" excludes the hoop, the shank, the clam, the rod, the clip and any of the other features of Brannon, the Examiner disagrees. It should be noted that "a consisting essentially of" claim occupies a middle ground between closed claims that are written in consisting of format and fully open claims that are drafted in a comprising format" *PPG Industiries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir 1998). Further, for the purposes of searching for and applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims what the basic novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. In this instance, the disclosed specification and the claims does not provide a clear indication what is regarded as constituting a material change, i.e., the dimensions of the plastic wire, in the basic and novel characteristics of the invention. Therefore, the Examiner has construed the phrase "consisting essentially of" as equivalent to "comprising".

For the reasons set forth above, this Office Action is made final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bena Miller
Primary Examiner
Art Unit 3725

bbm
November 28, 2005